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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/397,959 | 09/17/1999 | KARL ERIK STAHL | 927.1003 | 9455 |
| 21171 | 7590 | 10/21/2003 | EXAMINER | |
| STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005 | | | DUONG, DUC T | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2663 | 1 |

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/397,959 | STAHL, KARL ERIK |
| | Examiner | Art Unit |
| | Duc T. Duong | 2663 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 August 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-7 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Gorman et al (U.S. Patent 6,370,149 B1).

Regarding to claim 1, Gorman discloses a telecommunication apparatus 180 (Fig. 9 col. 5 lines 25-40) for initiating and receiving voice and data comprising a first port 190 (Fig. 9 col. 12 lines 39-41) to connect said apparatus to a circuit switched telecommunication network PSTN (Fig. 2 col. 3 lines 41-43), a second port 188 (Fig. 9 col. 12 lines 37-38) to connect said apparatus to a packet based telecommunication

network 40 (Fig. 2 col. 4 lines 23-25), and a gateway means 74 (Fig. 4 col. 6 lines 8-10) for establishing a path between said first port and said second port inside said apparatus in response to a request imbedded in an incoming call via said second port.

Regarding to claim 2, Jones discloses a third port 140 (Fig. 7 col. 8 lines 55-61) to connect a conventional telephone apparatus via said telecommunication apparatus to said first port.

Regarding to claim 4, Gorman discloses a telecommunication apparatus 180 (Fig. 9 col. 5 lines 25-40) for initiating and receiving voice and data comprising a first port 190 (Fig. 9 col. 12 lines 39-41) to connect said apparatus to a circuit switched telecommunication network PSTN (Fig. 2 col. 3 lines 41-43), a second port 188 (Fig. 9 col. 12 lines 37-38) to connect said apparatus to a packet based telecommunication network 40 (Fig. 2 col. 4 lines 23-25), and a gateway means 74 (Fig. 4 col. 6 lines 8-10) for establishing a path between said first port and said second port inside said apparatus in response to a request imbedded in an incoming call from the packet based telecommunication network, whereby said telecommunication apparatus can serve as part of a distributed gateway system (Gateway connected to both the PBDN and the PSTN as the backbone of the system as defined in the specification on page 18, lines 5-7) between said circuit switched telecommunication network and said packet based telecommunication network (Fig. 4 col. 6 lines 4-16).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gorman in view of Phillips et al (U.S. Patent 6,243,377 B1).

Regarding to claim 3, Gorman discloses all the limitation with respect to claim 2, except for a mechanism to automatically connect said third port directly to said first port in the event of power failure. However, Phillips discloses a simultaneous voice and data transmission apparatus includes a bypass circuit 54 provides a direct connection between the subscriber line (third port) and the output (first port) to the telephone network 19 in the event of a power failure (Fig. 5 col. 4 lines 44-48). Thus, it would have been obvious to one of ordinary skilled in the art, at the time of the invention, to include the bypass circuit as taught by Phillips in Gorman's with the motivation to enable continuous communication services.

6. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorman in view of Naudus (U.S. Patent 6,259,691 B1).

Regarding to claim 5, Gorman discloses all the limitation with respect claim 4, except for a gateway location servers connected to said packet based telecommunication network, said gateway location servers being adapted to receive a request from a first telecommunication apparatus connected to said packet based telecommunication network for telecommunication with a specified telephone apparatus on said circuit switched telecommunication network, and further being programmed to select a second of said telecommunication apparatuses to serve as gateway between

said networks for said requested connection, and to forward to said request to said second telecommunication apparatus via packet based telecommunication network.

However, Naudus discloses a telecommunication system (Fig. 1) comprising gateway location servers (gatekeeper 22, LDAP Directory 24, and DNS 25), linked to a packet-based network PBN 20, for translation of IP addresses of Internet Telephony gateways 40 (first telecommunication apparatus connected to PBN) and 80 (second telecommunication apparatus connected to PBN), see col. 7 lines 1-52. The gateway location servers contained an address database, wherein the first telecommunication apparatus 40 can query to obtain a transport address of the second telecommunication apparatus 80 for telecommunication between specified telephone 10-13 connected to local exchanges 16 and 17 (circuited switched network), see col. 8 lines 41-67.

Thus, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to include the gateway location servers as taught by Naudus in Gorman's system for routing translation of data over packet network.

Regarding to claims 6 and 7, Gorman discloses the packet based telecommunication network comprises the Internet (Fig. 2 col. 7 lines 24-27).

Response to Arguments

7. Applicant's arguments filed August 4, 2003 have been fully considered but they are not persuasive. Regarding to Applicant's argument on page 5, Gorman's gateway means 74 is in another location and not inside said apparatus as claimed, is directed to *In re Japikse*, 86 USPQ 70 (CCPA 1950). Herein, it is held by the Office that shifting

location of parts would not constitute any new inventive concept since the operation of the device would not be modified. Thus, shifting Gorman's gateway means 74 from the tandem location 30 to the apparatus 180 would not constitute any new inventive concept since the operation of the gateway would not be modified. Based on the reason set forth above, the rejection remains held.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc T. Duong whose telephone number is 703-605-5146. The examiner can normally be reached on M-Th (8:30 AM-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau T. Nguyen can be reached on 703-308-5340. The fax phone numbers

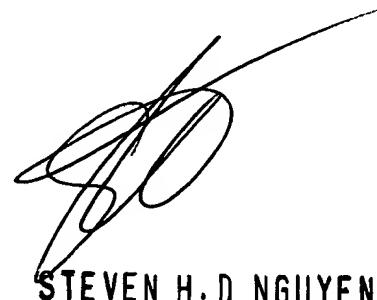
Art Unit: 2663

for the organization where this application or proceeding is assigned are 703-872-9314
for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or
proceeding should be directed to the receptionist whose telephone number is 703-305-
9600.

DD

October 7, 2003



STEVEN H. D. NGUYEN
PRIMARY EXAMINER